

### **REMARKS/ARGUMENTS**

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe and claim the subject matter which Applicants regard as the invention.

Claims 1-26 remain in this application. The Examiner has indicated that claims 1-15 and 18-21 are allowed.

Claims 16, 17, and 22-26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Okabe *et al.* ("Headphone response on real ears and a head and Torso simulator"), in view of Bennett (U.S. 4,079,198). For the following reasons, the rejection is respectfully traversed.

The references do not teach a microphone that is "connected to said speaker via said channel" wherein "said channel has an exit opening with said acoustic resistor between said speaker and said exit opening" as recited in claim 16. Similarly, the references do not teach an "acoustic resistor arranged between the speaker and an exit opening within a connecting channel connecting to one of the microphone and an exit of the probe" as recited in claim 26.

The Examiner admits that Okabe does not teach the acoustic resistor of the claim, but argues that col. 3, line 65 to col. 4, line 15, of Bennett teaches an acoustic resistor in a channel. However, the channel 54 having the resistor is not *between* the speaker and the opening as required by the claims. Instead, channel 54 is clearly open to ambient. Thus, it cannot be said that the acoustic resistor of Bennett is "between the speaker and an exit opening in a connecting channel to the microphone" as recited in

the claim. Further, the channel 54 is not connected to the microphone. Thus, Bennett does not teach all of the limitations of the claims.

Furthermore, the Examiner argues that col. 6, lines 20-45 of Bennett teaches resistors connected to an acoustic coupler. However, the resistors discussed in this section are clearly electrical resistors, not acoustic resistors, and thus not relevant to the claim language.

Accordingly, the references in combination do not teach all of the limitations of claims 16 and 26, and thus those claims are patentable over the references. The remaining rejected claims, which depend on one of claims 16 and 26, are also patentable over the references for at least the same reasons as the parent claim.

Furthermore, the Examiner has not provided the proper motivation for combining the references. Instead, the Examiner merely makes the conclusory statement that it would be "obvious" to combine the teachings, without providing any specific motivation. This is clearly improper and not sufficient to support a prima facie case of obviousness.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.). Accordingly, the rejection for obviousness is improper, and should be withdrawn.

Appln. No. 10/621,476  
Amdt. Dated October 7, 2005  
Reply to Office Action of June 10, 2005

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35624.

Respectfully submitted,  
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